

The Office has requested restriction under 35 U.S.C. § 121 to one of the allegedly independent and distinct inventions.

Group I: Claims 73-100 and 108, directed to tagged primers and oligonucleotides comprising tagged primers.

Group II: Claims 101-107 and 109-111, directed to a method for preparing tagged primers, capable of extension, that are base-paired to a template.

Group III: Claims 112-117, directed to an apparatus for detecting tagged oligonucleotide fragments.

The Examiner remarked that the inventions of I and II are related as a product and process of use. The inventions are stated to be distinct if either both of the following can be shown: (1) the process for using the product as claimed can be practical with another materially different product; or (2) the product as claimed can be used on a materially different process of using that product. The product of this invention is alleged to be used in a nucleic acid hybridization assay for detecting target nucleic acids.

Applicants hereby elect the invention of Group I but traverse the requirement for restriction between the inventions of Group I and Group II. Claims 101 through 107 and 109 through 111 have been amended herein to further point out the relationship between the allegedly independent inventions.

Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under MPEP §808, the Examiner must examine the subject application on the merits even though it includes claims to distinct inventions, if the search and examination of the application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely, 1) the inventions must be independent or distinct, and 2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that it would not be a serious burden on the Examiner to search and examine the inventions of Groups I and II. The invention of Group I is drawn to tagged primers and the invention of Group II as amended is directed to methods of making tagged oligonucleotides and primers as defined by claim 75. Therefore, a search of the art tagged

oligonucleotides and primers (Group I) would necessarily reveal methods of for making these tagged primers (Group II). Therefore, the search and examination of the invention of Group II with Group I would not be a serious burden on the Examiner.

In addition, pursuant to MPEP §802.01, "'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect...." Clearly, there is a disclosed relationship between the tagged oligonucleotides (Group I) and the methods of making these tagged oligonucleotides and primers (Group II).

Accordingly, in view of the preceding discussion, Applicants respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because Groups I and II are not independent under MPEP §802.01. Therefore, restriction is not proper under 35 U.S.C. §121.

Furthermore, assuming that the Examiner is correct in requiring restriction for dependent but distinct inventions, Applicants maintain that the inventions are not distinct. Under MPEP §802.01, distinct inventions are related, "but are capable of separate manufacture, use or sale as claimed...." Related is used as an alternative for dependent. In the subject application, the allegedly distinct inventions are dependent and thus, related.

In view of the preceding remarks, Applicants maintain that the allegedly distinct inventions are not distinct. Therefore, under MPEP §803, a restriction requirement is not proper.

III. CONCLUSION


Applicants respectfully request reconsideration in light of the proposed amendments and remarks set forth above. Applicants expressly reserve their right under 35 U.S.C. § 121 to file one or more divisional applications directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

Applicants further request examination of the elected subject matter on the merits.

No fee, other than the fee for the three month extension of time is deemed necessary in connection with the filing of this response. However, in the event the Assistant Commissioner determines that additional fees are required, Applicants authorize the Assistant Commissioner to charge any additional fee required for this submission to Deposit Account No. 03-1952 (Reference No. 24313-20001.05). However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By: 
Antoinette F. Konski
Registration No. 34,202

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018

Telephone: (415) 813-5730

Facsimile: (415) 494-0792